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12/11/91

Applicants : Paoletti et al.

Serial No. : 08/228,926

Filed : April 18, 1994

For : **MODIFIED VACCINIA VIRUS AND METHODS FOR
MAKING AND USING THE SAME**

Group Art Unit : 1813

Examiner : M. Mosher

530 Fifth Avenue
New York, New York 10036

EXPEDITED PROCEDURE
RESPONSE UNDER
37 C.F.R. § 1.116

37 C.F.R. §1.116
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TERMINAL DISCLAIMER

Assistant Commissioner for Patents
Washington, D.C. 20231
Box AF

NOV 22 1995

GROUP 1800

Sir:

HEALTH RESEARCH INCORPORATED ("HRI") has a place of business at Empire State Plaza Tower, Albany, New York, 12237.

HRI is the assignee of the entire right, title and interest in, to and under U.S. Patent application Serial No. 08/228,926, filed April 18, 1994 ("the above-captioned application"), as a continuation of U.S. Patent application Serial No. 07/881,995, filed May 4, 1992, as a division of application Serial No. 07/537,882, filed June 14, 1990, now U.S. Patent No. 5,110,587, which is a continuation of application Serial No. 07/090,209, filed August 27, 1987, which in turn is a

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division of U.S. Patent application Serial No. 06/622,135, filed June 18, 1984, now U.S. Patent No. 4,722,848, by virtue of an assignment from the inventors as set out at Reel: 4762, and Frame: 0791-0792, where said assignment was recorded at the U.S. Patent and Trademark Office on September 25, 1987 in application Serial No. 06/622,135.

HRI is the assignee of the entire right, title and interest in, to and under U.S. Patent application Serial No. 06/446,824, filed December 8, 1982, now U.S. Patent No. 4,603,112, by virtue of the aforementioned assignment from the inventors as set out at Reel: 4108, and Frame: 0174-0175, where said assignment was recorded at the U.S. Patent and Trademark Office on March 30, 1982 in application Serial No. 06/446,824.

U.S. Patent application Serial No. 06/446,824 issued as U.S. Patent No. 4,603,112 on July 29, 1986.

HRI hereby disclaims the terminal part of any patent granted on the above-captioned application which would extend beyond the expiration date of the full term of U.S. Patent No. 4,603,112 (17 years from Issue Date or 20 years from filing date, whichever is later).

HRI hereby agrees that any patent so granted on the above-captioned application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 4,603,112, this agreement to run with any patent granted on the above-captioned

application and to be binding upon the grantee, its successors or assigns.

No terminal part of any patent granted on the above-captioned application is disclaimed prior to the expiration of the full statutory term of U.S. Patent No. 4,603,112 in the event that said patent earlier expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or is terminally disclaimed under 37 C.F.R. 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to expiration of its full statutory term, except for the separation of legal title stated above.

In accordance with 37 C.F.R. § 3.73, the undersigned states that the evidentiary documents evidencing the chain of title from the original owner to the assignee have been reviewed, a copy of those documents are attached, and it is hereby certified that, to the best of the undersigned's knowledge and belief, title is in HRI seeking to take the action herein stated.

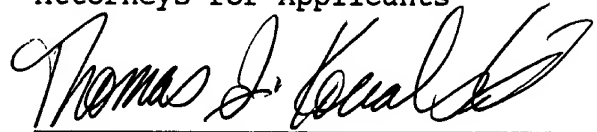
The undersigned further states that I am an attorney who has signed papers in this application and that I am authorized to execute this terminal disclaimer on behalf of HRI.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false

statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

CURTIS, MORRIS & SAFFORD, P.C.
Attorneys for Applicants

A handwritten signature in cursive script, appearing to read "Thomas J. Kowalski", written over a horizontal line.

Thomas J. Kowalski
Registration No. 32,147
(212) 840-3333

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MAY 6 9 15 AM '83
COURTIS MORRIS & SAFFORD PC

TO: NICHOLAS J. AQUILINO
2001 JEFFERSON DAVIS HWY.
#409
ARLINGTON, VA. 22202

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS -
- AVAILABLE AT THE U.S. PATENT AND TRADEMARK OFFICE ON THE REEL AND FRAME NUMBER REFERENCED BELOW. A DIGEST OF THE DOCUMENT HAS ALSO BEEN MADE AND APPEARS IN THE OFFICE'S RECORDS AS SHOWN:

ASSIGNOR: 001 PAOLETTI, ENZO
ASSIGNOR: 002 PANICALI, DENNIS

DOC DATE: 12/07/83
DOC DATE: 12/07/83

RECORDATION DATE: 03/30/83 NUMBER OF PAGES 002 REEL/FRAME 4108/0174

DIGEST: ASSIGNMENT OF ASSIGNORS INTEREST

ASSIGNEE: 501 HEALTH RESEARCH, INCORPORATED; EMPIRE STATE PLAZA TOWER, ALBANY, NY. 12237 A CORP OF NY.

SERIAL NUMBER 6-446824 FILING DATE 12/08/82
PATENT NUMBER ISSUE DATE 00/00/00

TITLE OF INVENTION: MODIFIED VACCINIA VIRUS AND METHODS FOR MAKING AND USING THE SAME

- INVENTOR: 001 PAOLETTI,
INVENTOR: 002 PANICALI,

ASSIGNMENT

Curtis, Morris and Safford, P.C.
File No. 45 P 123 CIP
Serial No. 446,824
Filing Date Dec. 8, 1982

We, Enzo Paoletti and Dennis Panicali
who reside respectively at
4 Furman Place, Delmar, New York 12054 and
R.D. 2, Averill Park, New York 12018

have made certain inventions or discoveries (or both) set forth in an application for
Letters Patent of the United States of America entitled

MODIFIED VACCINIA VIRUS AND METHODS FOR MAKING AND USING THE SAME
which application was executed by us on even date herewith

and Health Research, Incorporated, A corporation in the
State of New York
whose address is

Empire State Plaza Tower
Albany, New York 12237

and which, together with its successors and assigns is hereinafter called "Assignee",
is desirous of acquiring the title, rights, benefits and privileges hereinafter recited,
and of confirming the same or any part thereof heretofore acquired by Assignee.

Now, therefore, for valuable consideration furnished by Assignee to us, receipt
and sufficiency of which we hereby acknowledge, we hereby, without reservation:

1. Assign and convey to and confirm in Assignee the entire right, title and interest
in and to said inventions and discoveries, said application for Letters Patent of the
United States of America, any and all other applications for Letters Patent on said


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REC'D 100 10/11/82

or them, all acts reasonably serving to assure that the said inventions and discoveries, the said patent applications and the said Letters Patent shall be held and enjoyed by Assignee as fully and entirely as the same could have been held and enjoyed by us or our heirs or representatives if this assignment had not been made; and particularly to execute and deliver to Assignee all lawful application documents including petitions, specifications, and oaths, and all assignments, disclaimers, and lawful affidavits in form and substance as may be requested by Assignee; to communicate to Assignee all facts known to us relating to said inventions and discoveries or the history thereof; and to furnish Assignee with any and all documents, photographs, models, samples and other physical exhibits in our control or in the control of our heirs or legal representatives and which may be useful for establishing the facts of our conceptions, disclosures, and reduction to practice of said inventions and discoveries.

The effective date of this instrument is the 7th day of December , 1982 .

In testimony whereof we have affixed our signatures.

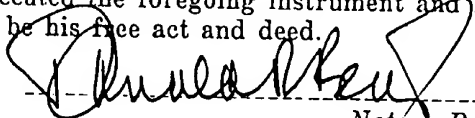

Enzo Paoletti

STATE OF New York
COUNTY OF New York

} ss.:

On this 7th day of December , 1982, before me
appeared Enzo Paoletti

to me known and known to me to be the person described in and who
executed the foregoing instrument and he acknowledged the same
to be his free act and deed.


Notary Public

(OFFICIAL SEAL)

DONALD R. BENTZ
Notary Public, State of New York

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REEL 4108 FRAME 1 / 3

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CURTIS, MORRIS & SAFFORD PC



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DOCKETED

TO: WILLIAM S. FROMMER
C/O CURTIS, MORRIS & SAFFORD
530 FIFTH AVE.
NEW YORK, NY 10036

RECEPTIONIST
RECEIVED

NOV 22 1995

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

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THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS
- AVAILABLE AT THE U.S. PATENT AND TRADEMARK OFFICE ON THE REEL AND FRAME -
NUMBER REFERENCED BELOW. A DIGEST OF THE DOCUMENT HAS ALSO BEEN MADE
AND APPEARS IN THE OFFICE'S RECORDS AS SHOWN:

ASSIGNOR: 001 PAOLETTI, ENZO
ASSIGNOR: 002 PANICALI, DENNIS

DOC DATE: 06/19/84
DOC DATE: 06/19/84

RECORDATION DATE: 09/25/87 NUMBER OF PAGES 002 REEL/FRAME 4762/0791

DIGEST: ASSIGNMENT OF ASSIGNORS INTEREST

ASSIGNEE: 501 HEALTH RESEARCH, INCORPORATED, EMPIRE STATE PLAZA TOWER,
ALBANY, NEW YORK 12237

SERIAL NUMBER 6-622135 FILING DATE 06/19/84
PATENT NUMBER 4,722,848 ISSUE DATE 02/02/88

TITLE OF INVENTION: METHOD FOR IMMUNIZING ANIMALS WITH SYNTHETICALLY M
ODIFIED VACCINA VIRUS

- INVENTOR: 001 PAOLETTI, ENZO
INVENTOR: 002 PANICALI, DENNIS

ASSIGNMENT

Curtis, Morris and Safford, P.C.
File No. 454310-2030
Serial No. 622,135
Filing Date June 19, 1984

We, ENZO PAOLETTI and DENNIS PANICALI,

who reside respectively at 31 Rutland Street, Albany, New York 12209 and
114 Nonset Path, Acton, Massachusetts 01720,

have made certain inventions or discoveries (or both) set forth in an application for
Letters Patent of the United States of America entitled -- METHOD FOR IMMUNIZING
ANIMALS WITH SYNTHETICALLY MODIFIED VACCINIA VIRUS (AS AMENDED) --.

which application was executed by us respectively on September 10, 1984 and
September 4, 1984,

and HEALTH RESEARCH, INCORPORATED, a corporation in the State of
New York,
whose address is Empire State Plaza Tower
Albany, New York 12237

and which, together with its successors and assigns is hereinafter called "Assignee",
is desirous of acquiring the title, rights, benefits and privileges hereinafter recited,
and of confirming the same or any part thereof heretofore acquired by Assignee.

Now, therefore, for valuable consideration furnished by Assignee to us, receipt
and sufficiency of which we hereby acknowledge, we hereby, without reservation:

1. Assign and convey to and confirm in Assignee the entire right, title and interest
in and to said inventions and discoveries, said application for Letters Patent of the
United States of America, any and all other applications for Letters Patent on said
inventions and discoveries in whatsoever countries, including all divisional, renewal,



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or them, all acts reasonably serving to assure that the said inventions and discoveries, the said patent applications and the said Letters Patent shall be held and enjoyed by Assignee as fully and entirely as the same could have been held and enjoyed by us or our heirs or representatives if this assignment had not been made; and particularly to execute and deliver to Assignee all lawful application documents including petitions, specifications, and oaths, and all assignments, disclaimers, and lawful affidavits in form and substance as may be requested by Assignee; to communicate to Assignee all facts known to us relating to said inventions and discoveries or the history thereof; and to furnish Assignee with any and all documents, photographs, models, samples and other physical exhibits in our control or in the control of our heirs or legal representatives and which may be useful for establishing the facts of our conceptions, disclosures, and reduction to practice of said inventions and discoveries.

The effective date of this instrument is the 19th day of June , 1984.

In testimony whereof we have affixed our signatures.


ENZO PAOLETTI

DENNIS PANICALI

STATE OF NEW YORK }
COUNTY OF NEW YORK } ss.:

On this 24th day of August , 19 87, before me
appeared ENZO PAOLETTI

to me known and known to me to be the person described in and who
executed the foregoing instrument and he acknowledged the same
to be his free act and deed.

MARIE R. PORCELLI
Notary Public, State of New York
No. 60-3134880
Qualified in Westchester County
Cert. Filed in New York County
Commission Expires March 30, 1989
Notary Public

(OFFICIAL SEAL)

STATE OF MASSACHUSETTS }
COUNTY OF MIDDLESEX } ss.:

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